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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/774,699	02/01/2001	Ichiro Fujita	1614.1122	3086
21171	7590	07/15/2005	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			PORTER, RACHEL L	
			ART UNIT	PAPER NUMBER
			3626	

DATE MAILED: 07/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/774,699

Applicant(s)

FUJITA, ICHIRO

Examiner

Rachel L. Porter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 February 2001 and 02 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 February 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the application filed 2/1/01 and the election filed 5/2/05. Claims 1-12 are pending. Claims 13-15 have been canceled.

Election/Restrictions

2. Applicant's election without traverse of Invention I (claims 1-12) in the reply filed on 5/2/05 is acknowledged.

Priority

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

4. The drawing of Figure 1 is objected to because it does not provide enough detail or description of the depicted system. It is noted that the original drawing of Figure 1 included in the Japanese priority document includes writing in each of the system components. The Examiner suggests translating this writing and including it in the system components for the version of Figure 1 in the instant US application.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate

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prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter.

In the present case, exemplary system claim 1 is drawn to a "system for mediating between at least one user...", but lacks a clear and deliberate nexus to any computerized or electronic device within the body of the claim. The recited elements in claim 1 of "a storage part" and "an insurance request," devoid of any clear nexus to computer system or electronic system, do not apply, involve, use, or advance the technological arts since all of the individual components may broadly read on non-technological elements such as a pencil and paper/forms ("insurance request part"), a file cabinet or table ("storage part"), etc.

A similar analysis may be applied to claims 5, and 9, which lack a clear and deliberate nexus to any computerized or electronic device within the body of the claim.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the invention is directed to a system for generating insurance quotes/estimates, and thus produces a useful, concrete, and tangible result.

Although the recited system produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained

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above, exemplary claims 1,5 and 9 are deemed to be directed to non-statutory subject matter.

Dependent claims 2-4 and 6-8 do not provide any further limitations that would serve to apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts", and are thus deemed to be non-statutory because they are not limited to the technological arts.

Similarly, for a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. In the present case, claims 10 and 11 only recite abstract ideas. The recited steps of merely obtaining information about a customer's products, storing the information, and performing and providing quotes/insurance estimates to the customers does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention produces quotations or estimates for insurance policies based upon stored information, and is therefore deemed to be useful, concrete and tangible.

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 10-11 are deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-2 and 9-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Joao (USPN 6,347,302).

[claim 1] Joao teaches a system for mediating the transmission of information among users via a network, said system comprising:

- a storage part in which purchase information related to products possessed by said at least one user is stored; and (col. 2, lines 33-49; col. 5, line 59-col. 6, line 6; lines 50-57)
- an insurance request part capable of requesting insurance on said products according to said purchase information stored in said storage part. (col. 8, lines 41-61)

[claim 2] Joao teaches the system as claimed in claim 1, wherein said insurance request part sends information includes at least maintenance of the product (col. 9, lines 15-40).

[claim 9] Joao teaches a system for managing information transfer over a network among a plurality of users, said system comprising:

- a storage part in which purchase information related to products possessed by said at least one user is stored; and (col. 2, lines 33-49; col. 5, line 59-col. 6, line 6; lines 50-57)
- an insurance request part capable of sending requests to said at least one insurer for making an insurance contract on said products according to said purchase information stored in said storage part. (col. 8, lines 41-61)

[claim 10] Joao teaches a method of mediating between users over a network, said method comprising the steps of:

- a) receiving purchase information related to products possessed by said at least one user; (col. 5, lines 38-58; col. 9, lines 16-42)
- b) storing said purchase information in a storage part; and (col. 9, lines 16-42)
- c) requesting insurance on said products according to said purchase information stored in said storage part. (col. 9, lines 26-col. 10, lines 24)

[claim 11] Joao teaches a method of managing information transfer over a network among users, said method comprising the steps of:

- a) receiving purchase information related to products possessed by said at least one user; (col. 5, lines 38-58; col. 9, lines 16-42)
- b) storing said purchase information in a storage part; and (col. 9, lines 16-42)

c) sending requests to said at least one insurer for making an insurance contract on said products according to said purchase information stored in said storage part. (col. 9, lines 26-col. 10, lines 24)

[claim 12] Claim 12 repeats the subject matter of claim 10 a computer readable medium storing instructions which cause a computer to perform the underlying method recited in claim 10. As the underlying process has been shown to be fully disclosed and computer implemented by the teachings of Joao in the above rejection of claim 10, it is readily apparent that the Joao reference includes computer readable medium with instructions to cause a computer to perform the recited functions. As such, these limitations are rejected for the same reasons provided in the rejection of claim 10 and incorporated herein.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Joao as applied to claim 1 above, and further in view of Official Notice.

[claim 3] Joao teaches a system for insuring gathering and exchanging information on products from a user and submitting a request for insurance for the products (col. 9,

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lines 26-col. 10, lines 24), but does not expressly disclose that the insurance request part sends information for collectively insuring a plurality of products with a single insurance contract. However, it is respectfully submitted that it is old and well known in the insurance art to carry multiple coverages on a single contract or to insure more than one item on a single contract. For example, automobile owners who have multiple cars will often place all cars on a single policy. At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the teaching of Joao to allow the user to insure multiple products with a single insurance contract. One would have been motivated to include this feature to streamline the process of insuring the products.

10. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Joao as applied to claim 1 above, and further in view of Lockwood (USPN 4,567,359).

[claim 4] Joao teaches the system of claim 1 as explained in the rejection of claim

1. Joao further discloses a system that provides insurance quotes and contracts for a product as requested by a user and based upon stored data (col. 9, lines 44-col. 10, line 35), but does not expressly disclose gathering insurance estimates from a plurality of insurers. Lockwood teaches a system which receives estimates from a plurality of insurers and which prepares a contract for insurance with the selected insurer. (col. 2, lines 8-19; col. 5, lines 44-col. 6, line 32) At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system of Joao with the teaching of Lockwood to include gather estimates from a plurality of insurers

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and to prepare a contract for insurance with the selected insurer. As suggested by Lockwood, one would have been motivated to include these features to allow the prospective insured to obtain quotations from various institutions quickly and easily, and to compare quotations at leisure or to obtain a policy on the spot. (col. 3, lines 33-37)

11. Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joao, and further in view of Solomon et al (USPN 6,847,935).

[claim 5] Joao a system for mediating the transmission of information among users via a network, said system comprising:

- a first storage part in which purchase information related to products possessed by said at least one user is stored; (col. 2, lines 33-49; col. 5, line 59-col. 6, line 6; lines 50-57)
- an insurance request part which requests insurance on said products according to said purchase information stored in said storage part. (col. 8, lines 41-61)

Joao teaches a system which includes a first storage stores purchase related information on products possessed by the user and also includes an insurance request component as explained above. However, Joao does not expressly disclose a second storage component with an identifier and guarantee related information from at least one manufacturer for each product to be insured. Solomon discloses a system, which stores identifier and guarantee (i.e. warranty) for multiple manufacturer products. (col. 6, lines 3-35; lines 51-55) The storage component includes transaction codes/ UPC's/ SKU's/ product descriptions (i.e. manufacturer product identifiers) and information on

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warranties. At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system of Joao with the teaching of Solomon to store the recited data. As suggested by Solomon, one would have been motivated to include this feature to provide the system with greater flexibility, especially in accommodating the needs and preferences of the consumers (Solomon: col. 6, lines 48-55)

[claim 6] Joao and Solomon teach the system as claimed in claim 5 as explained in the rejection of claim 5. Furthermore, Joao teaches a system wherein said insurance request part sends information includes at least maintenance of the product (col. 9, lines 15-40).

12. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Joao and Solomon as applied to claim 5, and further in view of Official Notice.

[claim 7] Joao teaches a system for insuring gathering and exchanging information on products from a user and submitting a request for insurance for the products (col. 9, lines 26-col. 10, lines 24), but does not expressly disclose that the insurance request part sends information for collectively insuring a plurality of products with a single insurance contract. However, it is respectfully submitted that it is old and well known in the insurance art to carry multiple coverages on a single contract or to insure more than one item on a single contract. For example, automobile owners who have multiple cars will often place all cars on a single policy. At the time of the Applicant's invention, it

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would have been obvious to one of ordinary skill in the art to modify the teaching of Joao to allow the user to insure multiple products with a single insurance contract. One would have been motivated to include this feature to streamline the process of insuring the products.

13. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Joao and Solomon as applied to claim 5 above, and further in view of Lockwood.

[claim 8] Joao and Solomon teach the system of claim 5 as explained in the rejection of claim 5. Joao further discloses a system that provides insurance quotes and contracts for a product as requested by a user and based upon stored data (col. 9, lines 44-col. 10, line 35), but does not expressly disclose gathering insurance estimates from a plurality of insurers. Lockwood teaches a system which receives estimates from a plurality of insurers and which prepares a contract for insurance with the selected insurer. (col. 2, lines 8-19; col. 5, lines 44-col. 6, line 32) At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system of Joao and Solomon in combination with the teaching of Lockwood to include gather estimates from a plurality of insurers and to prepare a contract for insurance with the selected insurer. As suggested by Lockwood, one would have been motivated to include these features to allow the prospective insured to quotations from various institutions quickly and easily, and to compare quotations at leisure or obtain a policy on the spot. (col. 3, lines 33-37)

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Cullen et al (USPN 6,272,528) teaches a system that allows user to receive insurance quotes from multiple carriers.
- Rogers et al (USPN 5,978,774) teaches a system for electron product registration.
- Atwater et al (WO 01/90846 A2) teaches a system for pricing warranties for products.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel L. Porter whose telephone number is (571) 272-6775. The examiner can normally be reached on M-F, 9:30-6:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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